

REMARKS

I. Status of the Claims

Claims 24-76 are pending in this application. Claims 25-33, 38-48, 50-73, and 76 were withdrawn from consideration by the Examiner.

II. Elections/Restrictions

The Examiner acknowledged Applicants' election of Group I, claims 24, 34-37, 49, 74, and 75 in the previous Response to Restriction Requirement. Although the election, as well as the 35 U.S.C. § 103 rejection, states that claims "49-74" have been elected and rejected, it is Applicants' understanding that the Examiner intended to acknowledge election of claims 49 and 74 since claims 50-73 were withdrawn from consideration by the Examiner. Accordingly, Applicants request that the Examiner clarify that claims 50-73 were not rejected in the next communication from the Office.

III. Rejection Under § 103

The Examiner has rejected claims 24, 34-37, 49, 74,¹ and 75 under 35 U.S.C. § 103(a) as being unpatentable over Young et al. (U.S. Patent No. 6,113,890) ("Young") for the reasons disclosed on pages 2 and 3 of the Office Action. Applicants traverse this rejection for at least the following reasons.

Applicants submit that the Examiner has failed to satisfy the burden of proof for setting forth a prima facie case of obviousness. The Examiner has not made the

¹ As set forth above, Applicants understand that claims 50-73 were withdrawn from consideration by the Examiner, and thus were not intended to be included in this rejection.

requisite showing, as is set forth in M.P.E.P. § 2142, that there is some suggestion or motivation to modify the reference.

The Examiner alleges that Examples IV and IX of Young teach a shampoo comprising “ammonium laureth sulfate and sodium lauryl sarcosinate an anionic surfactant and amphoteric surfactant, respectively, and an organic oil in an aqueous carrier.” Office Action at page 3. Applicants respectfully submit that sodium lauryl sarcosinate is not amphoteric, and disagree with the Examiner’s characterization of it as such. Indeed, the very reference the Examiner cites for the rejection lists sodium lauryl sarcosinate as an *anionic* surfactant. See Young, at col.4, line 28. Thus, in contrast to the Examiner’s assertion, Applicants submit that Example IV does not comprise an amphoteric surfactant.

Moreover, the Examiner acknowledges that neither of the two cited examples teach the presently claimed carboxylic acid esters since the Examiner alleges that it would be obvious to have modified the disclosed formulations of Young by substituting the organic oils used therein with the fatty acid esters of the reference. As the motivation for this modification, the Examiner, without explanation, states it to be “the expectation of successfully producing a shampoo composition with similar effects.” Office Action at page 3.

The Examiner has shown no evidence, however, why one skilled in that art making the modification would choose to select the claimed carboxylic acid esters from the myriad of carboxylic acid esters disclosed in the reference. See Young at col. 10,

lines 25-37. Moreover, there is no evidence why one skilled in that art would choose the claimed carboxylic acid ester from the several different types of organic oils disclosed in Young. See Young at col. 9-11, lines 50-9. The carboxylic acid esters are not even a requisite part of Young's invention, which adds to the substantial amount of selection that would be necessary in an attempt to arrive at the claimed invention.

At best, the cited reference would have made the claimed invention obvious to try. In moving from the prior art to the claimed invention, however, one cannot base a determination of obviousness on what the skilled person might try or find obvious *to try*. Rather, the proper test requires determining what the prior art would have led the skilled person *to do*. The Federal Circuit has reinforced this precedent in a number of decisions. See, e.g., *In re O'Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988).

In the present case, the prior art, at best, provides general guidance to use a broad class of organic oils in combination with a broad class of surfactants. Only in hindsight could it have been obvious to modify the reference teachings in an attempt to arrive at the presently claimed invention. Thus, the prior art may, at most, make it obvious to try various carboxylic acid esters in combination with various surfactants disclosed in Young, but such an obvious to try standard does not provide the *prima facie* basis for a rejection under section 103. *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1374, 56 USPQ 2d 1065, 1075 (Fed. Cir. 2000).

Moreover, Applicants submit that, Permethyl 102A, the isoparaffin that the Examiner suggests may be substituted for the claimed carboxylic acid ester, is present

in an amount of only 0.5 weight percent in the composition of Example IX, which is outside the “greater than 1% weight” recited in independent claim 24. Thus, not only has the Examiner not set forth the proper motivation to substitute the isoparaffin of Example IX with the claimed carboxylic acid ester, the Examiner has failed to suggest what would lead one skilled in the art to do so within the claimed weight percentage.

Finally, the Examiner has not even addressed the limitation of claim 24 which requires “the anionic surfactant: amphoteric surfactant ratio by weight being less than or equal to 3:1,” which neither of the cited examples meet. As explained above, Example IV does not comprise an amphoteric surfactant at all. Example IX comprises 12% anionic surfactants (ammonium laureth sulfate and diammonium laurylsulfosuccinate) and 3% amphoteric surfactant (cocoamidopropylbetain). Thus, the anionic surfactant to amphoteric surfactant ratio of Example IX is 4 and not within the bounds of the claimed ratio.

Accordingly, Applicants request that this ground of rejection be withdrawn.

IV. Double Patenting Rejection

The Examiner rejected claims 24, 34-37, 49, 74, and 75 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 20-22, 26, and 27 of U.S. Patent No. 6,432,908 (“the ‘908 patent”). Office Action at page 4.

Applicants respectfully submit that the Examiner has clearly failed to meet the burden of establishing that the present claims would have been obvious over the claims

of the '908 patent. Nevertheless, in order to advance prosecution of this application, Applicants have filed concurrently herewith a Terminal Disclaimer over U.S. Patent No. 6,432,908. Accordingly Applicants request that this ground of rejection be withdrawn.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Debarshi Rahul Das
Reg. No. 55,100

Dated: March 8, 2004

652014v1